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| SERIAL NUMBER | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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449942 07/449,942 12/29/89 RANDUX

C

EXAMINER

REICHLER, K

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| ART UNIT | PAPER NUMBER |
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338

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DATE MAILED:

04/17/91

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 12/21/90 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

| | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. Claims 28-63 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims 1-22 have been cancelled.

3. Claims _____ are allowed.

4. Claims 28-63 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

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Claims 28-63 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 28-63 are still replete with improper claim syntax. For example, in regard to claim 28, step (c) appears to be incomplete, i.e. what about "introducing". In step (d), line 3, after "the", --at least one-- should be inserted. In step (e), lines 1-2 and 3, before "fertilized", --at least one-- should be inserted and "ovocytes" should be --ovocyte--. Step (e) would be in better form if rewritten as --(e) accessing the uterine cavities through the exit area of the container without removal of the container from the uterine cavity to enable transfer of the at least one fertilized ovocyte through the exit into the uterine cavity without the removal of the at least one fertilized ovocyte from the uterine cavity between fertilization and transfer--. In regard to claim 29, the claim recites structure which does not manipulatively affect the method. In regard to claims 29-35, a positive connection between the steps of claim 28 and these claims should be defined. For example, claim 29 could be rewritten as --Process according to claim 28, wherein the step of accessing includes opening the exit area prior to the step of lodging--. Claim 31 could be rewritten as --Process according to claim 28 further comprising the step of, upon accessing the uterine cavity through the container,

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ejecting the contents of the container into the back of the uterine cavity--. In regard to claim 36, the language of lines 2-3 and 4-6 recite intended use only and does not further limit the structure of the combination. It also should be noted that claim 36 does not include the concept set forth in the last Office Action. Claim 36 could be rewritten as follows: Device for intro-uterine fertilization in mammals comprising container means sized for introduction and lodging in the uterine cavity of the mammal for containing a culture medium, at least one ovocyte of the mammal and spermatozoa, while introduced into and lodged in the uterine cavity of the mammal for a time period sufficient to allow fertilization of the at least one ovocyte, said container means including means for defining an exit area to allow access to use uterine cavity without removing the container from the uterine cavity and enabling transfer of the at least one fertilized ovocyte from the container means into the uterine cavity without removal thereof from the uterine cavity between fertilization and transfer.-- It should be noted that these examples are merely illustrative of the informalities in the claims. The claims should be carefully reviewed and reversed.

Claims 28-63 avoid the art and if, as stated in the last office action, Applicant's concept is set forth and the informalities overcome, the claims would be allowable.

Applicant's general comments have been noted.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

R. Green
RANDALL L. GREEN
SPE
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PM
K. Reichle/dr
April 05, 1991
April 12, 1991
703-308-0858